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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,737	07/20/2001	Jonathan Gressel	01/22288	8906

7590

09/16/2002

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/889,737

Applicant(s)

Greene

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/20/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-13 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The preliminary amendments filed on 20 July 2001 have not been entered in this US national phase application. One amendment, with a heading of "Serial No. 09/\_\_\_\_\_" and "filed concurrently" and "Docket 01/22288", instructing changes to claims 6-10 and 12, was unsigned. The other amendment, with a heading of "PCT/IL00/00046" and "filed 24 January 2000" and "Docket 00/20550", appeared to be intended for entry into the PCT rather than the instant National Phase application, since it also included responses to art rejections made in the written opinion in the PCT, but never made in the instant U.S. application. Furthermore, the claim amendments comprised of replacement claim pages are of incorrect amendment format under 37 CFR 1.121(c). Accordingly, originally filed claims 1-13 have been treated with respect to the following restriction requirement.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a process for preventing transgene introgression into weeds comprising producing apomictic crop seed.

Group II, claim(s) 2, drawn to a process for preventing transgene introgression from a multigenomic crop species into weeds comprising cytogenically selecting for the presence of the transgene on a crop species chromosome which is incompatible with a weedy species.

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Group III, claim(s) 3-4 and 13, drawn to a process for preventing transgene introgression into weeds comprising linking the transgene to a control element inexpressible in the weed.

Group IV, claim(s) 5-11, drawn to a process for preventing transgene introgression into weeds comprising linking the first transgene to a second transgene deleterious to the weed.

Group V, claim(s) 12, drawn to a method of preventing transgene introgression into weeds comprising cytogenically selecting engineered crop species containing the transgene linked to an endogenous crop species gene which is deleterious to the weed.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The claims are linked by the technical feature of genetically engineering a crop species to prevent introgression of a transgene into a related weedy species. However, this feature is not special because it does not constitute an advance over the prior art. Daniell et al (1988) teach tobacco transformation with a plastid-specific herbicide resistance gene, wherein said gene is not transmitted to the pollen and therefore cannot be introgressed into related weedy species (see, e.g., page 345, Abstract).

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions. The inventions of Groups I-

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V are drawn to five different processes, each utilizing physiologically and biochemically divergent starting materials and processes not required by the other, such as apomixis-inducing genes, multi-genomic crop species, cytogenic examination, weed-inexpressible control elements, a second transgene which is deleterious to weeds, and an endogenous crop gene which is deleterious to weeds.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and fields of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 11, 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180/1638

